



811104

1644
Jew

Express Mail Label No. _____

Dated: _____

Docket No.: 20052/1200517-US3
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Randolph J. Noelle et al.

Application No.: 09/467,317

Art Unit: 1644

Filed: December 20, 1999

Examiner: P. Gambel

For: USE OF ANTIBODIES THAT SPECIFICALLY
BIND CD40CR (CD40 LIGAND) TO INHIBIT
HUMORAL IMMUNITY

RESPONSE TO OFFICE COMMUNICATION UNDER 37 CFR 1.105

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants herewith file a response to the Office Communication dated July 7, 2004 (Paper No. 07062004). The Examiner has requested Applicants to provide "the Decision on the Interference [in application USSN 08/742,480] as well as related information (e.g. Exhibits, Declarations, etc.) and appeals which will directly affect or be directly affected by or have a bearing on the decision in the pending application [USSN 09/467,317]" since the "Examiner has determined [such information] is reasonably necessary to the examination of this application." Further, the Examiner has "reminded [applicants that if] ... Applicant[s] do not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item."

Applicants understand the foregoing to require them to provide papers from:

(i) “Noelle v. Lederman” (Interference No. 104,415, appealed to the Federal Circuit 02-1187, decided January 20, 2004);

(ii) “Noelle v. Armitage” (Interference No. 104,724); and

(iii) the presently pending appeal of Interference No. 104,724, i.e., The Trustees of Dartmouth College and Idec Pharmaceuticals Corporation v. Immunex Corporation, Civil Action No. 03-CV-02676-ORD (W.D.Wa. Sept. 3, 2003) (“the Washington action”),

rather than to make a substantive determination, which Applicants have not done, to determine which papers from (i-iii) may “directly affect or be directly affected by or have a bearing on the decision in the pending application [USSN 09/467,317] ”.

(i) Noelle v. Lederman: Applicants have provided the Examiner with a published opinion from the Federal Circuit, Noelle v. Lederman, 69 USPQ2d 1508 (Fed. Cir. 2004), 02-1187, which was an appeal from Interference No. 104,415, along with the Appeal Briefs from both sides.

(ii) Noelle v. Armitage: Applicants cannot readily obtain this item of required information. Applicants, through counsel, have consulted with counsel for the defendant in the Washington Action, who stated that he would have to review the designated documents for confidentiality since providing the documents may make them part of the public record upon potential issuance of the present patent application. As defendant’s counsel has not had sufficient time to review the Interference files and has not given authorization for Applicants to submit an independent set of these files in the present case prior to the deadline for response, Applicants respectfully suggest that the Examiner look to the file in USPTO Interference No. 104,724. Upon the Examiner’s identification of specific documents in the Interference file that he deems relevant to the decision in the present, Applicants, through counsel, would facilitate any requests for permission from defendant’s counsel to enter the documents into the file history of the present application.

(iii) The Washington Action: Applicants cannot readily obtain this item of required information within the period set to respond to the Examiner’s request. There is a Protective Order {W:\20052\1200517us3\00231016.DOC [REDACTED] }

in the Washington Action that prevents public disclosure of certain papers and information from that Action which fall under the terms of the Order. In light of the Examiner's RFI in the underlying application, Applicants, through counsel, have obtained authorization from counsel for the defendant in the Washington Action to disclose to the Examiner all such papers from the Action -- even assuming that any of those papers may be within the provisions of the Protective Order. Further, to facilitate the Examiner's consideration of the papers from (iii) above, a CD-ROM containing digital images of those papers in the possession of Applicants' counsel is currently being prepared for filing. As the process of converting digital files to CD has taken longer than anticipated, applicants will send the CD under separate cover. Should there be any problems with accessing the images on the CD, the Examiner is invited to telephone the undersigned.

The Examiner should be further advised that Applicants are supplying in the CD-ROM all papers in their counsel's possession, which may not be, in fact, every single paper from (iii) above. Should that be the case and should the Examiner desire any one of such papers (should they be, in fact, missing), then Applicants will make all reasonable efforts to obtain any such missing paper.

Dated: August 9, 2004

Respectfully submitted

By 

Bert J. Lewen

Registration No.: 19,407

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 753-6237 (Fax)

Attorneys/Agents For Applicant